

Response to Non Final Office Action mailed August 5, 2010

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested. To this end, petition is hereby made for a *three (3) month extension of time* to respond to the outstanding Office Action of August 5, 2010. Although the fee for the extension of time is being submitted with this Amendment, the Commissioner is hereby authorized to charge any fee that should have been filed at this time to our Deposit Account No. 14-1140.

Claims 1 – 5, 7 and 9 -35 are pending in the application. Upon entry of this Amendment, claims 1, 10, 11, 20, 21, 33 and 35 will be amended, and claims 5, 15, 22, 23, 27 and 28 will be cancelled.

In the outstanding Office Action, the Examiner rejected claims 1 – 4, 10, 12 – 14, 16, 18, and 20 – 21 under 35 U.S.C. §103(a), as being unpatentable over Kolbert (USPN 4,985,922) in view of Zarinetchi (USPN 6,324,430), and in view of Schulman (USPN 4,071,032). The Examiner also rejected claims 5, 7, 11, 15, 17, 22 – 31, and 33 – 35 under 35 U.S.C. §103(a), as being unpatentable over Kolbert, Zarinetchi and Schulman, as above, and also “predictable results”. The Examiner further rejected claims 9, 19 and 32 under 35 U.S.C. §103(a), as being unpatentable over Kolbert, Zarinetchi and Schulman, as above, and further in view of Winkler (USPN 5,527,348). The Examiner’s rejections are respectfully traversed.

For a claimed invention to be obvious over a combination of prior art references, there must be some reason that would have led one of ordinary skill in the art to combine the references to produce the claimed invention.

First, in this regard, Applicant hereby repeats and thus incorporates herein by reference the arguments made in the Amendments filed June 22, 2010 and September 9, 2009.

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Second, here, independent claims 1, 10, 11, 20, 21 and 33 of the present application have been further amended to recite that the core(s) extend(s) past the magnetizable casing(s) along the longitudinal extension(s) of the coil(s), as seen in the direction towards the front ends of the coil(s).

Thus, even assuming, *arguendo*, that the Examiner properly combined the cited references, the claimed invention is not obvious over such references because they fail to disclose or suggest, either alone or in combination an apparatus and method for wirelessly transferring energy, in which the core inside of the coil generating the alternating magnetic field extends past the magnetizable casing along the longitudinal extension of the coil, as seen in the direction towards the front end of the coil.

The Examiner admits as much in his rejection of claims 5, 7, 11, 15, 17, 22 and 23 under §103(a) as being obvious over Kolbert, Zarinetchi and Schulman. 8/5/10 Office Action, pp. 4 – 5, para. 11.

With regard specifically to the Examiner's rejection of claims 5, 7, 11, 15, 17, 22 and 23 under §103(a) as being obvious over Kolbert, Zarinetchi and Schulman, the Examiner recognizes, that these references fail to teach a core longitudinally extending beyond the length of a shield and cut-out slots on the sides of the shield. Nevertheless, the Examiner again argues that it would have been obvious to one of ordinary skill in the art to modify the system of Kolbert in view of Zarinetchi and Schulman “with providing [sic] cut-out slots on the side of the shield which would yield a system where the core and coil windings extend longitudinally beyond the shield for providing the predictable results of providing ventilation for the skin surface and dissipation of any excess heat energy stored within the shield member.” 8/5/10 Office Action, pp. 4 – 5 (Emphasis added).

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However, the Federal Circuit has held that when an Examiner makes a patentability determination that a claimed invention is obvious over the prior art, the Examiner must rely on "concrete factual evidence" to make the factual findings to support a §103(a) rejection. *See In re Zurko*, 258 Fed.3d 1379, 1385-86 (Fed. Cir. 2001). The *Zurko* decision requires an Examiner to provide concrete factual evidence to support his determination that the rejected claims are not patentable because they are obviousness over the cited prior art.

In *Zurko*, the claimed invention was directed to a method for more efficiently creating a secure or "trusted" computer environment. The Examiner rejected the claimed invention under 35 U.S.C. §103, relying on a combination of two prior art references, *i.e.*, the UNIX Operating System ("UNIX") and a program (Dunford, FILER Version 2.20 ("FILER 2")) for repeating potentially dangerous commands before execution. In sustaining the rejection, the Patent Office Board of Appeals "contended that even if the cited UNIX and FILER 2 references did not disclose a trusted path, 'it is basic knowledge that communication in trusted environments is performed over trusted paths' and, moreover, verifying the trusted command in UNIX over a trusted path is 'nothing more than good common sense.'" *Zurko*, 258 F.3d at 1385. On appeal, the Federal Circuit rejected the Board's contentions, holding:

With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

Zurko, 258 F.3d at 1385-86. (Emphasis added).

The same is true with respect to the Examiner's rejection of claims 5, 7, 11, 15, 17, 22 and 23 under §103(a) as being obvious over Kolbert, Zarinetchi and Schulman and relying on

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"predictable results". Clearly, it is not proper for the Examiner to rely on the above-noted assertions of "predictable results" to support his §103(a) rejection of these claims. Rather, the Examiner must point to some "concrete evidence in the record" to support his assertion of obviousness. This he has not done.

The Examiner has made essentially the same "predictable results" rejection in the last three office actions issued March 9, 2009, December 23, 2009 and the current outstanding Office Action of August 5, 2010.

Applicant cited the *Zurko* case in the Amendment filed September 9, 2009 in response to the March 9, 2009 Office Action, essentially repeated it "by incorporation" reference in the Amendment filed June 22, 2010 in response to the December 23, 2009 Office Action, and specifically repeats it in this Amendment. Notwithstanding this, the Examiner has NEVER addressed the issue of not complying with his obligation set forth in the *Zurko* case to point to some "concrete evidence in the record" to support his assertion of obviousness. As noted above, unless the Examiner supplements the record in this application to further support his §103 "expected results" rejection, as required by *Zurko*, independent claims 1, 10, 11, 20, 21 and 33, which now recite the feature of the core inside of the coil generating the alternating magnetic field extends past the magnetizable casing along the longitudinal extension of the coil, as seen in the direction towards the front end of the coil, MUST be allowed.

In the latest, outstanding Office Action of August 5, 2010, the Examiner is now citing a total of four references to reject the claims pending in this application, as opposed to the three used in the prior Office Action of December 23, 2009. Given this, it is clear that the Examiner is using hindsight to argue that combining Kolbert, Zarinetchi and Schulman or Winkler would have been obvious, and that when combined, they would result in the apparatus and method for

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wirelessly transferring energy described in amended independent claims 1, 10, 11, 20, 21 and 33 of the present application. Clearly, this is improper. The Federal Circuit has warned against using a claimed invention as a “blueprint” for piecing together elements in the prior art to defeat the patentability of a claimed invention:

As this court has stated, “virtually all [inventions] are combinations of old elements.” . . . Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”

In re Rouffet, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). (Citations omitted).

This conclusion is supported by the Examiner’s use of some non-analogous art to reject claims directed to an apparatus and method for wirelessly transferring energy from outside a human’s or animal’s body into the human’s or animal’s body to an implantable energy consuming medical device when implanted in the human’s or animal’s body. The primary Kolbert reference is directed to an inductive coupling for the bi-directional transfer of data and power through the skin of an aircraft to avoid pin connectors. The tertiary Schulman reference is directed to an implantable living tissue stimulator, a function that is very different from wirelessly transferring energy into a human’s or animal’s body.

As such, it is clear that amended independent claims 1, 10, 11, 20, 21 and 33 are not obvious over the combination of Kolbert, Zarinetchi and Schulman or Winkler. And, since each of dependent claims 2 – 4, 7, 9, 12 – 14, 16 – 19 and 24 – 35 depend from one of independent claims 1, 10, 11, 20, 21 and 33, such dependent claims are also not obvious over a combination of Kolbert, Zarinetchi and Schulman or Winkler.

FORSELL, Peter
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In view of the foregoing, it is believed that all of the claims remaining in the application, *i.e.*, claims 1 – 4, 7, 9 – 14, 16 – 21 and 24 – 35, are now in condition for allowance, which action is earnestly solicited. If any issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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